

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William J. FARRELL, Jr. et al.

Serial No.: 10/696,583

Group Art Unit: 3635

Filed: October 30, 2003

Examiner: William V. Gilbert

For: WIRE MESH SCREED

APPELLANT'S REPLY BRIEF

Appellant respectfully submits this short reply to address the lynchpin of the Examiner's position – that the Appellant is relying on the intended use of the invention as opposed to structural differences between the invention and the prior art. Appellant respectfully submits that the Examiner's premise is incorrect in that the claims do recite specific structural differences from the prior art and that Appellant is not relying on an intended use but rather the new, nonobvious and useful attributes of the invention.

1. The Examiner Does Not Appreciate that “Screed Ridge” Denotes a Specific Structure and is Not an “Intended Use”

All of the claims on appeal recite the structural limitation of “screed ridges” by virtue of the language in independent claims 22 and 32. Specifically, both claims 22 and 32 include the limitation of “wire mesh members **defining** . . . outwardly projecting **screed ridges** extending parallel to one another a length of said wire mesh members.” As clear from the plain meaning of the claim language, the wire mesh members physically define the structure of screed ridges. A screed ridge is a physical structure having an understood meaning in the art. The Examiner completely ignores this physical, structural meaning in rejecting the claims.

To be more clear, a “screed” is understood in the art to be “a long piece of metal or wood, attached to a wall or ceiling intended to be used as a guide to

ensure the straight, level, and uniform thickness of plaster or stucco." See The Metal Lath Handbook, Gary J. Maylon, (1st Ed. 2003) at p. 28 (Glossary of Lathing Terms).¹ Appellant's specification discusses screeds and clearly uses the term according to its ordinary and accustomed meaning:

[0003] **Screed systems** are known in the art. For example, in a traditional method of plastering a wall product, ceiling, or floor, without the placing of tiles on the wall product thereafter, **wooden float strips** are used to guide a straight edge across an area forming the wall product being plastered, while raking off excess mud, etc. left in the application of the mud. **The float strips, or "screeds"** are tapped into the prepared or wet mud, such as mortar, cement, or other suitable materials, with a separate level held against one or more of them to obtain a horizontal, vertical, or other orientation or plum. . . .

[0004] As will be appreciated, the difficulties with prior art **screed systems** are particularly acute with respect to preparing walls, such as foundation walls for buildings. In many prior art techniques, a craftsman looking to plaster a wall would have to prepare initial mud columns by hand on the wall. These columns would be erected for accepting a **screed** which would be used to allow the wall to be filled and cut to a uniform depth. However, mud columns crafted by hand were never truly uniform and difficult and time consuming to construct. . . . For example, the **screeds** could not be put into place until the building materials were into place and ready for finishing.

As described in the specification excerpts above, the prior art had a major drawback in that skilled labor was required to erect mud columns and then skillfully tap "screeds" into their correct position to allow for the wall to be cut to a uniform depth. Appellants claimed invention solved the problems in the art through the provision of construction panels making use of wire mesh members having screed ridges formed therein.² The significance of this structural difference between the present invention and the prior art is described at length in the specification:

¹ Appellant is not attempting to rely on new evidence but rather using this reference demonstrably for ease of understanding the argument that follows.

² Appellant in the specification, its opening brief, and through the Declaration of Mark Heath submitted in evidence, discuss at length the significance of the invention and its nonobviousness and those arguments will not be repeated herein.

[0007] An advantage of the invention lies in that the wire mesh members may be configured to include a plurality of *V-shaped impressions which will serve as a visual and mechanical built-in screed.*

* * * *

[0052] In view of the fact that there is a ½ inch gap 115, see Figure 1, between each wire mesh members 101, 102 and the middle member 110, one inch of finishing material should result in the wire mesh being embedded about half way therein. In addition, *given that the wire mesh was provided with two ½ inch deep V-shaped impressions 105, 106, the apex 150 of the impressions serves as a visual screed for the application of the finishing materials and then as a mechanical screed (allowing a 48-inch blade to be slid up and down the apexes of the impressions) to ensure the wall is cut flat* and ready to be finished with, for example, a stucco look.

[0053] Notably, as will be appreciated by one of ordinary skill in the art, the wall can be erected with the impressions running horizontally (see Figure 1) or vertically (see Figure 5). In either case, *the panel can be cut with a screed blade running along the apexes of the V-shaped impressions.*

* * * *

[0059] . . . Figure 7 also shows a 1 3/16-inch layer of concrete 330 as a finishing material applied to both sides of the panel *and smoothed using the three built in screed notches 304, 305, and 306.*

The Examiner has taken the specification's discussion of the advantages achieved by the novel structure and argues that the Appellant is relying on an unclaimed use of the invention. See Examiner Answer at 12 ("[I]t is noted that the features upon which applicant relies (i.e., the use of the screed as provided in the disclosure) are not recited in the rejected claims(s)."). Again, Appellant submits that the provision of built-in screeds, as that term is understood in the art, is new, useful and nonobvious in view of the prior art. The Examiner is simply ignoring that the claimed "screed ridges" define a structural limitation that is not taught or suggested in the prior art.

The Examiner's position is akin to denying there are physical differences between a chair with a back and a chair with a back and arm rests. While the term "arm rest" does describe the intended use of the structures, the term nevertheless connotes a definitive structure in the art. Not giving weight to an "arm rest" limitation in a claim would be improper. Also, while true that the back of a chair may serve as an arm rest if someone sits in it sideways, or the seat of

the chair may literally allow someone to rest their arms, that does not mean that the prior art has "arm rests." That is not how claims are to be examined and measured for patentability. Rather, the standard requires ascertaining the differences between the prior art and the claims at issue, which requires properly interpreting the claim language, and then considering both the invention and the prior art references as a whole. See MPEP 2141.02. If the structural limitation of the term "screed ridge" is fairly applied (e.g., given its broadest *reasonable* interpretation), and the correctly construed claims fairly compared to the prior art, it is clear that the Examiner has failed to make a prima facie case of unpatentability. The prior art simply does not disclose a construction panel having wire mesh members defining a plurality of parallel screed ridges.

2. The Prior Art Relied Upon by the Examiner Does Have "Screed Ridges"

The prior art relied upon by the Examiner as meeting the screed ridges limitation does not teach or suggest such a structure. Specifically, the Strand reference shows a checkerboard matrix of wires having a regular pattern of bumps, which the Examiner calls outwardly extending "apices," caused by the stapling of portions of the wires to a composite. These bumps, or "apices" do not meet the physical structure of "screed ridges." The Strand reference's apices, or bumps, are not long, straight, flat, of a uniform depth or otherwise capable of allowing a board/edge/level to be pulled across them to cut a coating to provide a flat, smooth, and uniform layer. If one were to treat the bumps as screeds, the resultant coating would be a bumpy, uneven, surface - the antithesis of the claimed invention. Again, the Examiner is not giving due weight to the structure required by the properly construed claim limitations.

Applicant respectfully submits that a fair reading of the claims and prior art demonstrates that not only is the claimed invention physically and demonstrably different than the prior art, but also that the claimed invention goes against the great weight of the teaching in the art for constructing and finishing panels (and

allows for use of unskilled labor and off-site construction if desired) by the specific physical differences between the invention and the prior art.

CONCLUSION

Appellant respectfully submits that the rejections of claims 22-35 are erroneous and reversal of the same is respectfully requested for the reasons of record as clarified herein.

Respectfully submitted,
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